

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

mcf/tww

Mailed: November 28, 2007

Concurrent Use No. 94002124

Woodstock's Enterprises, Inc.
(Oregon)

v.

Woodstock's Pizza, Inc.
(substituted for Woodstock's
Pizza, LLC as defendant)

Thomas W. Wellington,
Administrative Trademark Judge:

The Board acknowledges that this proceeding and the subject applications have sat dormant for a significant amount of time. We regret any inconvenience caused to the parties.

Background

Concurrent use applicant, Woodstock's Enterprises, Inc. (an Oregon corporation and hereinafter "Woodstock Oregon"), filed two applications on January 23, 2001, Serial Nos. 76199098 and 76199099, seeking registration of the marks WOODSTOCK'S and SLICE OF WOODSTOCK'S, respectively, subject to concurrent use in the area comprising the entire United States, except the State of California. Registration No. 2425957 for the mark WOODSTOCK'S is identified in both applications as the only excepted use.

In a prior proceeding, Concurrent Use No. 94001171, the Board adjudicated the concurrent use rights of Woodstock Oregon's application for the mark WOODSTOCK'S PIZZA PARLOR (stylized with a design) that matured into Registration No. 1614417. Registration No. 2425957, owned at the time by Woodstock's Enterprises, Inc. (a California corporation) was the identified excepted use/ user in the concurrent use proceeding.

Since the Board Concurrent Use proceeding, the Registration No. 2425957 has been assigned twice over. Woodstock's Enterprise, Inc. (California Corporation), the original owner, assigned the registration to Woodstock's Pizza, LLC (recorded on September 3, 2003, at reel/frame nos. 2818/0553). And, Woodstock's Pizza, LLC assigned the registration to Woodstock's Pizza, Inc. (recorded on February 3, 2006, at reel/frame nos. 3240/0067). In the latter assignment, we note that it was executed on March 9, 2005.

Woodstock's Pizza, Inc. Substituted as Defendant

At the time of institution of this proceeding, the second assignment identified above had not been filed with the Office. Thus, Office records showed the excepted user registration as being owned by Woodstock's Pizza LLC and the proceeding was instituted as such. Because it has now come to the attention of the Board that Woodstock's Pizza, Inc. is the current owner of the excepted use registration, and was the

owner at the time proceedings were instituted, it is hereby ordered that Woodstock's Pizza, Inc. be substituted as a party defendant. See TBMP § 512 (2d ed. rev. 2004).

Concurrent Use Application Serial No. 76199099

In view of the fact that the parties are the same and the issues are nearly identical with respect to the two applications, Application Serial No. 76199099 is hereby included in this concurrent use proceeding.

Show Cause As to Why This Concurrent Use Proceeding Should Not Be Terminated and Registrations Issue Based on Prior Board Proceeding

When the matter of concurrent use has already been adjudicated in a prior Board proceeding, a concurrent use applicant may be entitled to registrations without the need for a concurrent use proceeding, because the excepted user's rights have already been determined and judicial economy dictates a resolution to this matter. See TBMP § (2d ed. rev. 2004) and authorities cited therein. The reasoning is unaffected by any assignment in the subject excepted user registration. See, e.g., *Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1455 (TTAB 1991) (granting motion for summary judgment where assignee's rights had been determined in prior Board concurrent use proceeding).

In this proceeding, it appears that concurrent use applicant is entitled to registrations (for the two subject concurrent use applications) based on the prior Board

proceeding, Concurrent Use No. 94001171. Specifically, we note the following:

- 1) the applications are entitled to registration subject only to the concurrent lawful use of the party, now assignee, to the prior concurrent use proceeding;
- 2) the Board's prior decision specifies applicant's right to concurrent registration (as evidenced by applicant's Registration No. 1614417);
- 3) the concurrent use applications comply with the Board's prior decision by specifying the same geographic area, for substantially the same mark, and for the identical services.

A copy of the Board decision in Concurrent Use Proceeding No. 94001171 and the Commissioner's order restricting Registration No. 2425957 have been made a part of this proceeding file along with the application files.

In view thereof, the parties are allowed **thirty (30) days** from the mailing date of this order to show cause why the Board should not terminate this concurrent use proceeding and forward the subject concurrent use applications for issuance of registrations based on the Board's decision in Concurrent Use No. 94001171. (The applications will be amended to note that concurrent use registration is based on the prior Board proceeding.)

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